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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92041776
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Registration No. 2,684,138: PAVERCAT
Registered on the Principal Register on February 4, 2003, in International Class 7

CATERPILLAR INC., Petitioner, v. PAVE TECH, INC., Registrant.	Cancellation No. 92041776

PAVE TECH'S BRIEF IN OPPOSITION TO CANCELLATION PROCEEDING

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TABLE OF AUTHORITIES

Cases

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STATEMENT OF THE ISSUE

Pursuant to 37 C.F.R. § 2.128, Registrant Pave Tech, Inc. ("Pave Tech") submits this brief in opposition to Petitioner Caterpillar, Inc.'s ("Caterpillar") petition to cancel ("the Petition") Registration No. 2,684,138 for the mark PAVERCAT, and in response to Caterpillar's supporting brief.

Petitioner has alleged that the PAVERCAT registration, covering "machines or machine parts used to aid in the installation of segmental pavers" is likely to cause confusion with Petitioner's registrations for the marks CAT, CATERPILLAR, the CAT design mark, and the CATERPILLAR design mark. For the reasons set forth below, Pave Tech submits that Caterpillar has failed to show that there is a likelihood of confusion between Pave Tech's registered mark and Caterpillar's marks. Moreover, Pave Tech vigorously denies any accusation that it adopted its mark in bad faith. Accordingly, Pave Tech respectfully requests that Caterpillar's petition for cancellation be denied.

RECITATION OF FACTS AND ARGUMENT

By virtue of its federal registration, Pave Tech is entitled to a prima facie presumption that its registration and the mark PAVERCAT are valid, that it is the rightful owner of such registration and the mark PAVERCAT, and that it has the exclusive right to use the mark in connection with the goods identified in the registration. 15 U.S.C. § 1057(b). Caterpillar has the burden of proof in this proceeding, and must rebut the presumption of validity by a preponderance of the evidence. Martahus v. Video Duplication Services, Inc., 3 F.3d 417, 421, 27 U.S.P.Q.2d 1846, 1850 (Fed. Cir. 1993). Cancellation of Pave Tech's registration, upon which valuable business good will has been built, "should be granted only with due caution and

after a most careful study of all the facts." Rockwood Chocolate Co. v. Hoffman Candy Co., 372 F.2d 552, 555, 152 U.S.P.Q. 599, 601 (C.C.P.A. 1967) (citations omitted).

The proper test for determining whether a likelihood of confusion exists is set forth in In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). Analysis of the du Pont factors reveals that the mark PAVERCAT is not likely to cause confusion, or to cause mistake or to deceive with respect to Caterpillar's marks, *as previously determined by the Examining Attorney in issuing Pave Tech's federal registration in the first place.*

First and foremost, the marks PAVERCAT and CATERPILLAR or CAT are not sufficiently similar, especially in light of Pave Tech's addition of the word PAVER at the *beginning* of its mark. The only similarity between the marks is the word "cat," which is insufficient given the placement and emphasis of this word in Pave Tech's mark.

Second, the goods covered by the respective registrations are sufficiently dissimilar. Caterpillar dedicates pages and pages to the notion that Pave Tech's PAVERCAT machine is equivalent to Caterpillar's skid steer loader. At the same time, however, Caterpillar admits in its brief that, "*the PAVERCAT material handler* ***cannot*** *perform the same functions as a skid steer loader.*" Caterpillar Brief at 49. Moreover, Pave Tech's registration covers machines or machine parts ***used to aid in the installation of segmental pavers***. Not one of Caterpillar's asserted trademark filings identify segmental paving equipment. As the Board is constrained to evaluate similarity of the goods on the basis of the descriptions set forth in the relevant trademark filings, Caterpillar's arguments related to its other activities are entirely irrelevant. See Paula Payne Products Co. v. Johnson Publishing Co., 473 F.2d 901, 902, 177 U.S.P.Q. 76 (C.C.P.A. 1973).

In addition, Caterpillar's construction machinery and Pave Tech's segmental paver installation equipment are bought by sophisticated purchasers making careful purchasing decisions given the high cost of these items. And, despite years of concurrent use, Caterpillar cannot point to one instance of actual confusion caused by Pave Tech's mark PAVERCAT.

In short, Caterpillar has failed to prove by a preponderance of the evidence that Pave Tech's mark PAVERCAT is likely to cause confusion with Caterpillar's marks. Instead, Caterpillar's painstakingly lengthy brief details such irrelevant activities as its NASCAR sponsorship while slinging unfair attacks at Pave Tech and its products. Pave Tech respectfully asserts that Caterpillar's allegations regarding the quality of the PAVERCAT product are not only unfounded and unfair, but wholly inappropriate. Moreover, Pave Tech vigorously denies Caterpillar's unsupported conclusions – *not evidence* - that Pave Tech adopted its mark in bad faith. Pave Tech's honest recognition that it had heard of the company known as "Caterpillar" prior to adopting a trademark that happens to incorporate the letters "c-a-t" hardly constitutes bad faith, especially in light of Pave Tech's honest belief that its mark is not confusingly similar to Petitioner's marks, supported by its federal trademark registration.

Pave Tech maintains that there is no confusing similarity caused by its mark PAVERCAT, a position wholly supported by fact that the U.S. Patent and Trademark Office granted Pave Tech a federal registration for its mark. Accordingly, Pave Tech respectfully requests that Caterpillar's petition for cancellation be denied.

Respectfully submitted,

PAVE TECH, INC.

By its attorneys,

Date: Feb. 15, 2006

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